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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,923	12/21/2001	William R. Matz	36968/267874 (BS01424)	5050

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EXAMINER

LE, UYEN T

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 07/14/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,923

Applicant(s)

MATZ ET AL.

Examiner

Uyen T. Le

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-21 and 23-36 is/are rejected.
- 7) ☒ Claim(s) 15 and 22 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because the status of related applications cited at page 1 has not been updated

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 6-14, 17, 19, 20, 21, 24-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Hendricks et al (US 6,463,585) provided by the applicant.

Regarding claim 1, Hendricks discloses all the claimed subject matter (see the abstract, column 3, lined 30- column 4, line 17, column 59, line 52- column 60, line 13, column 63, line 59- column 64, line 21, column 66, line 58- column 67, line 44). The claimed "receiving a preference...database" is met by the fact that the access history file is received by the network controller. The claimed "searching a content...said preference", "receiving a first option list...an option" and "delivering...subscriber" are met by the fact that the subscriber is presented a menu of options (see column 58, lines 16-23).

Regarding claim 4, the content-access-history database in the method of Hendricks has to comprise a category attribute as claimed in order to match advertisements to subscribers preferences.

Regarding claims 6, 7 Hendricks discloses a television viewing history database (see the abstract).

Regarding claim 8, Hendricks discloses multi-level menu of options (see column 16, line 55- column 17, line20).

Regarding claim 9, Hendricks discloses an electronic program guide (see Figure 2).

Regarding claim 10, the claimed image displayed on a television screen merely reads on the advertisement delivered to a viewer (see the abstract).

Regarding claim 11, the option menu of Hendricks clearly provides access to a second option list since Hendricks teaches multi-level menus (se column 17, lines 9-11).

Claim 12 merely reads on the fact that the option in Hendricks allows viewers to access targeted advertisements (see column 58, lines 16-23).

Regarding claim 13, Hendricks discloses sending the option list to a television set-top box (see the abstract, Figure 1).

Regarding claim 14, the option list is clearly displayed for viewer selection (see column 58, lines 16-23).

Claims 17, 19, 20, 21 correspond to a computer program product to perform the method of claims 1, 4, 13, 14, thus are rejected for the same reasons stated in claims 1, 4, 13, 14 above.

Claims 24, 25, 26, 27, 32, 33 correspond to a system for claims 1, 4, 6, 7, 9, 12, thus are rejected for the same reasons stated in claims 1, 4, 6, 7, 9, 12 above.

Regarding claims 28, the option list creator application has to comprise and application executing on a set-top box in the method of Hendricks since the user of the set-top box can select from the menu of options (see column 58, lines 16-23).

Regarding claim 29, Hendricks discloses said option list creator application comprises an application executing on a processor in a content provider facility when Hendricks shows that targeted advertisements are generated by the network controller and signal processor (see column 57, lines 6-15).

Regarding claim 30, Hendricks discloses a cable television provider head-end facility (see column 57, lines 16-21).

Regarding claim 31, Hendricks discloses said option list creator application comprises a menu creator application (see column 58, lines 16-23).

Regarding claim 34, Hendricks discloses said content source comprises a cable television station (see column 57, lines 16-21).

Regarding claim 35, Hendricks discloses said content source comprises a video-on-demand server (see Figure 12, item 306).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 3, 5, 16, 18, 23, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendricks et al (US 6,463,585) provided by the applicant.

Regarding claim 2, although Hendricks does not specifically show a preference rating attribute, it would have been obvious to one of ordinary skill in the art to include such an attribute in order to select advertisements for specific viewers.

Regarding claims 3, 5, 16, 18, 23, although Hendricks does not specifically show sorting as claimed, it would have been obvious to one of ordinary skill in the art to do so in order to rank advertisements according to viewers preferences.

Regarding claim 36, although Hendricks does not specifically show a content source of personal video recorder, it would have been obvious to one of ordinary skill in the art to include any source in order to obtain available content of interest to a subscriber.

Allowable Subject Matter

4. Claims 15, 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not disclose or make obvious searching a content database for content unrelated to subscriber preferences and adding said non-preference-related option to the option list.

Conclusion

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5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hendricks (US 6,408,437) teach suggesting programs offered on a television program delivery system.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T. Le whose telephone number is 703-305-4134. The examiner can normally be reached on M-F 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12 July 2004



UYEN LE
PRIMARY EXAMINER